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In re Application of :
Audrey Goddard et al :
Serial No.: 10/063,728 : PETITION DECISION
Filed: May 8, 2002 :
Attorney Docket No.: GNE.3230R1C157 :

This is in response to the petition under 37 CFR 1.181, filed September 26, 2005, requesting withdrawal of finality of the last Office action.

BACKGROUND

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on February 7, 2005, setting a three month shortened statutory period for reply. The Office action set forth a priority date determination limiting priority to the filing date of this application. The Office action rejected claims 1-6, 8-10 and 14-20 under 35 U.S.C. 112, second paragraph, for indefiniteness. Claims 1-20 were rejected under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, for lack of utility and lack of enablement and lack of written description. Claims 1-10 and 12-20 were also rejected under 35 U.S.C. 102(b) over Lal et al (WO 00/00610) or Jacobs et al (WO 00/09552), based on the priority date accorded.

Applicants filed a reply on May 12, 2005 (Certificate of Mailing dated May 7, 2005), and replied to each ground of rejection set forth. Applicants also canceled claims 1-3, 7-10 and 15, amended claims 4-6, 11-12, 14 and 16-17 and added claims 21-31. Deletion of four inventors was also requested. Argument was made for an earlier priority date.

The examiner mailed a Final Office action to applicants on July 25, 2005, setting a three month shortened statutory period for reply. The examiner withdrew rejections under 35 U.S.C. 112, first paragraph, based on lack of written description, utility and enablement, in part, and under 35 U.S.C. 112, second paragraph. The examiner maintained a rejection under 35 U.S.C. 112, first paragraph, for lack of enablement for claims 4-5, 14 and 16-31, and for lack of written

description for claims 4-5, 7, 14 and 16-31. The examiner stated that the rejection under 35 U.S.C. 102 was being maintained, however changed the section of 35 U.S.C. 102 relied upon from (b) to (e), based on a newly determined priority date of August 24, 2000. The same references, Lal et al and Jacobs et al, were applied.

Applicants replied by filing this petition on September 26, 2005, and concurrently filing a reply to the Office action. The reply has not been acted on pending decision on the petition.

DISCUSSION

Applicants request withdrawal of finality of the Office action of July 25, 2005, based on the examiner setting forth a new ground of rejection using the same references, not necessitated by applicant amendments.

It is noted that in response to the first Office action applicants did file a number of claim amendments as well as adding new claims. Applicants' arguments also required the examiner to redetermine the priority date the application was entitled to and modify application of any art rejections accordingly. Thus the new rejections appear to be a result of applicants' amendments. However, the examiner did not state that the rejection under 35 U.S.C. 102(e) was a new rejection, nor did the examiner conclude the Office action by stating that any new grounds of rejection were necessitated by applicants' amendment. Further, rejections under 35 U.S.C. 102(e) can be based only on US patents or patent publications, not WO publications (unless filed after 11/29/00) as here advanced. Note M.P.E.P. 706.02(a):

Revised 35 U.S.C. 102(e) has two separate clauses, namely, 35 U.S.C. 102(e)(1) for publications of patent applications and 35 U.S.C. 102(e)(2) for U.S. patents. 35 U.S.C. 102(e)(1), in combination with amended 35 U.S.C. 374, created a new category of prior art by providing prior art effect for certain publications of patent applications, including certain international applications, as of their effective United States filing dates (which will include certain international filing dates). Under revised 35 U.S.C. 102(e), an international filing date which is on or after November 29, 2000 is a United States filing date if the international application designated the United States and was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. Therefore, the prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date (if all three conditions noted above are met) or an earlier U.S. filing date for which priority or benefit is properly claimed.

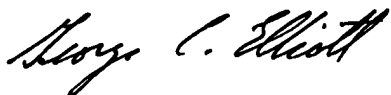
Thus the rejection appears to be improper based on the WO references relied on having been filed before November 29, 2000. As it is unclear whether the examiner intended to rely on this section of 35 U.S.C. 102 or another section is unclear as the section is not reproduced in the Office action as is customary. Only 35 U.S.C. 102(b) is reproduced in the previous Office action.

DECISION

The petition is **GRANTED**. Finality of the last Office action is withdrawn and the Office action is considered a non-Final Office action.

The application will be forwarded to the examiner for consideration of the reply filed September 26, 2005, as a reply to a non-Final Office action.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

A handwritten signature in cursive script, reading "George C. Elliott".

George C. Elliott
Director, Technology Center 1600